



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/797,978

03/10/2004

David Clarence Hager

05-902-J

5004

63572

7590

08/20/2008

MCDONNELL BOEHNEN HULBERT @ BERGHOFF LLP
300 SOUTH WACKER DRIVE
SUITE 3100
CHICAGO, IL 60606

EXAMINER

GORDON, BRIAN R

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,978	Applicant(s) HAGER ET AL.	
	Examiner Brian R. Gordon	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,7,8,10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 12-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 8, 10-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-17-08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2008 has been entered.

Response to Arguments

2. Applicant's arguments filed July 17, 2008 have been fully considered but they are not persuasive.

Applicant has deleted the "configured to seal" phrase with the term "seals". The amended remains insufficient to further limit the structural limitations of the seal plate. As previous stated claim 1 is directed to "a seal plate". The claim is not directed to a combination of a seal plate, multi-well block, and guide plate. The portion of that references the multi-well block and guide plate are directed to the intended use of the seal plate with the unclaimed multi-well block and guide plate. The desired interaction with the unclaimed elements is not further limiting of the seal plate. If applicant intends for the manner in which the device is intended to be used or arranged with the multi-well block and guide plate applicant should draft claims that specifically claim such an arrangement or the process of using the structures.

Applicant has amended the claim to incorporate a negative limitation not previously claimed. Applicant has attempted to define the apparatus by what is not rather than positively disclosing what elements define the apparatus. The written description does not explicitly disclose or describe the negative limitation as required. Applicant asserts Figure 3 supports the negative limitation. The examiner respectfully disagrees. Figure 3 is a cross sectional view of the upper portion of the multi-well block not the seal plate as asserted by applicant. Even if the figure were directed to the seal plate it shows a cross-sectional view of the bottom of a well not the entire surface. As such, the figure does not show a solid bottom surface of a well comprising no aperture as asserted by applicant.

Furthermore the term "perforable" seems to contradict the negative limitations. For example, the perforated boundaries between the sheets of paper towels include holes.

Like claim 1, claim 2 is directed to the intended use of the seal plate with the unclaimed multi-well block. As previously stated the multi-well block and guide plate are not claimed in combination with the seal plate or as elements of the seal plate. The multi-well block and guide plate are separate devices that are intended to be used in conjunction with the seal plate. Further limiting those unclaimed elements do not translate into further structural elements of the seal plate. In view of such claims 2-3, 5, 7-8, and 10-11 are not considered further structurally limiting of the seal plate.

Applicant asserts the instant application has an effective priority date of US Provisional Application No. 60/274,262. **There is no claim for any priority (domestic**

or foreign in the Oath/Declaration. Furthermore applicant has failed to show where the invention as claimed is fully supported in the provisional application to be granted such priority. In view of such the references relied upon are considered proper prior art.

The provisional application that applicant asserts applicant should be granted priority for was filed on March 3, 2001. The instant application was filed on March 10, 2004. The applications were/are not co-pending.

Applicant asserts the duck-bill valve is considered an aperture. The examiner respectfully disagrees.

As to Berray applicant asserts, Berray fails to disclose a well-like structure that matingly seals the opening of the corresponding well. The argument is not commensurate in scope with that of the claim. The claim is directed to a seal plate. Only the structural limitations of the seal plate are at issue. The intended use or interaction with corresponding wells of an unclaimed multi-well block or guide plate is not further limiting.

In view of such the claims are rejected as given herein.

Claim Objections

3. Claims 2-3, 5, 7-8, 10-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims are not further limiting because the multi-well block and guide plate are not elements of the seal plate. Claim 1 is directed to a seal plate. The multi-well block and

Art Unit: 1797

guide plate are not positively claimed as elements of the seal plate, but are mentioned in the narrative form as describing how they both are intended to be used with the claimed seal plate. Claims 2-3 are directed to the multi-well block and guide plate, respectively. As such those claims are not further limiting. The seal plate can be used with any plate or containers one chooses.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-3, 5, 7-8, 10-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As explained above there is no support for the negative limitation of claim 1.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, 5, 7-8, and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Roberts et al. US 20030143124.

Roberts et al. disclose a well plate seal that includes a mat heading a plurality spaced apart wells (that form protrusions on one surface) for engaging and sealing a plurality of exit ports in a multi -well filtration/extraction plate (abstract).

8. Claims 1-3, 5, 7-8, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Berray et al. US 20020187077.

Berray et al. disclose a flexible elastomer closure plug mat presents a plurality of protruding hollow septa closure plugs depending from the mat's lower face. The mat and protruding closure plugs are preferably formed of silicone rubber, with a thick layer of polytetrafluoroethylene or Teflon durably bonded to the lower face of the mat and to the outer faces of all of the arrayed plurality of closure plugs. The arrayed plurality of closure plugs are dimensioned for telescoping insertion into the open tops of a corresponding plurality of sample vials held in a well plate, and for frictional engagement therein (abstract).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R Gordon/
Primary Examiner
Art Unit 1797